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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,530	12/05/2003	Michael Ganser	LWEP:104aUS	8287
24041	7590	05/06/2004	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,530	Applicant(s) GANSER, MICHAEL	
	Examiner Thong Q Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/915012.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/5/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/915,012, filed on 7/25/2001. ***Drawings***

2. The formal drawings contain two sheets of figures 1-2 filed on 12/05/2003 have been received by the Office.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In particular, the "interface 26" as stated in the specification at page 3, section [0012], line 4 is not shown in at least one figure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The following correction is suggested to applicant to amend the specification for the purpose of update the information of the parent application. In page 1, section [0001], the information thereof --, now U.S. Patent No. 6,717,725—should be added after "July 25, 2001".

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 4 is rejected under 35 USC 112, first paragraph because the specification does not teach that the microscope stand processes the same shape and configuration regardless of the application. Applicant is respectfully invited to review the specification, in particular, in page 2, section [0005], for example, in which the specification discloses that the inventive device can be used for different microscope types and sizes. As such, different types and sizes of microscopes will have different microscope stands in types and configurations.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 3 is rejected under 35 USC 112, second paragraph for the following reasons: 1) The claim recites a control unit (see line 2); however, it is entirely

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unclear about the relationship between the control unit recited in claim 3 and the box containing at least one control and power supply unit recited in its base claim

1. Applicant should note that the inventive device as described in the specification discloses a box supporting at least one control and power supply unit wherein the box is able to locate away or separately from the microscope body and the box is able to use with different microscopes. Beyond that, the specification does not teach another control unit; 2) Each of the features "the same physical dimensions" (line 2) and "the application" (line 3) is indefinite. What kind of "physical dimensions" and "the application" does applicant imply here?

b) Claim 4 is rejected under 35 USC 112, second paragraph because it is unclear about the so-called "the application" recited on line 3 of the claim.

c) Claim 5 is rejected under 35 USC 112, second paragraph because each of the features "the illumination unit" (line 3); "the microscope" (line 3); and "the illumination device" (line 5) lacks a proper antecedent basis.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-5, as best as understood, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,717,725. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims 1-2 of the Patent '725 disclose a microscope having a box containing at least one control and power unit which box is separated from the stand of a microscope and connected to the microscope via a cable and an illuminating unit located inside the box.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-4, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Remer et al (U.S. Patent No. 5,559,631).

Remer et al disclose an illuminating system for a microscope. The microscope comprises a stand (1). The illuminating system comprises a set of light sources (4, 5) which is housed in its own housing; a box (8) located removed from the light source housings and the microscope stand wherein the box houses at least one power supply and control units for controlling the operation of the light

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sources. The box is connected to the light source housings by wire leads (13, 12) and also comprises an interface (11) which is connected to a computerized system (16) which is understood by one skilled in the art comprises keyboard or equipments for entering data to control the operation of the microscope and the illuminating system. It is clearly that the illuminating box with its own dimensions as provided by Tamura et al can be used to provide illumination to different types of the microscope having a microscope stand. See columns 3-5 and fig. 1.

14. Claims 1 and 3-5, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Tamura et al (U.S. Patent No. 5,325,231).

Tamura et al disclose an illuminating system for a microscope. The microscope comprises a microscope stand (61). The illuminating system comprises a box located remotely from the microscope stand and houses a light source unit (90) with its power supply, and a light control unit (92) wherein light emitted from the light source unit is guided to the microscope via the fiber cable (84). It is clearly that the illuminating box with its own dimensions as provided by Tamura et al can be used to provide illumination to different types of the microscope having a microscope stand. See columns 11-12 and fig. 10.

Conclusion

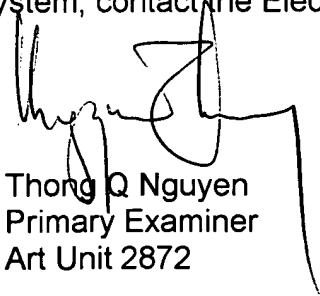
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen
Primary Examiner
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